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In re Application of	:	
NEWTON, et al.	:	
Application No.: 10/521,417	:	DECISION ON PETITIONS
PCT No.: PCT/EP03/06753	:	
Int. Filing Date: 25 June 2003	:	UNDER 37 CFR 1.137(b)
Priority Date: 05 July 2002	:	
Attorney Docket No.: SC0978EG	:	AND 37 CFR 1.47(b)
For: TRANSMITTER AND RECEIVER GAIN	:	
CALIBRATION BY MEANS OF FEED-	:	
BACK IN A TRANSCEIVER	:	

This decision is in response to the petitions filed 03 August 2006 in the United States Patent and Trademark Office (USPTO) under 37 CFR 1.137(b) to revive the present application and under 37 CFR 1.47(b) to accept the application without the signature of co-inventors Anthony Newton and Heinz Lehning.

BACKGROUND

On 03 July 2006, applicant was mailed a communication and notice of abandonment informing applicant that the petition under 37 CFR 1.47 filed 03 March 2006 was untimely and that the application was abandoned as to the National stage in the United States.

On 03 August 2006, applicant filed the petitions discussed herein.

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 03 August 2003 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided a proper response to the Form PCT/DO/EO/905 mailed 01 July 2005 in the form of a petition under 37 CFR 1.47. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

II. Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items 1 and 3 above.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." Applicant states that the inventors were mailed complete sets of the application papers along with a declaration and assignment document for execution on 12 April 2005 and to date have not responded. However, it is unclear from applicant's exhibits 1-3 whether the inventors signed for these parcels or whether they were left without a signature required. This is especially important in instances such as the present where the inventor's silence is being taken as a refusal to sign. In addition, applicant has not provided any firsthand evidence of the preparation and mailing of the application papers to assure that a complete set was in fact mailed.

In addition, it appears that the e-mail of Ms. Barbe only contained a declaration document and an assignment document. Applicant has not provided a statement from Ms. Barbe explaining whether the e-mail to Mr. Newton was opened or if he responded, where she got a current e-mail address from and why Mr. Lehning did not receive an e-mail.

Regarding item 4, the filed declaration is unsigned. Applicant has provided a statement under 37 CFR 3.73(b) signed by Mr. Robert King on behalf of Freescale Semiconductor, Inc., however, applicant needs to file a declaration executed by an authorized officer of the assignee, Freescale Semiconductor, Inc. on behalf of the corporation and on behalf of the non-signing inventors. The declaration must detail the signing individual's title and right to execute the declaration on behalf of the corporation. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

(B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

As to item (5), applicant has not provided proof of proprietary interest in the invention in that the only assignment document provided is between Motorola, Inc. and Freescale Semiconductor, Inc. Applicant has not provided a showing as to the relationship of the non-signing inventors and Motorola, Inc other than an unsigned assignment document. MPEP 409.03(f) provides for cases where a signed assignment is not present:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

While applicant has provided a portion of the Swiss Civil Law Code which states that employers maintain the rights to inventions made by an employee in the performance of his duties, a signed legal memorandum has not been provided. In addition, applicant has not submitted any evidence to confirm that Mr. Newton and Mr. Lehning created the invention during their employment with Motorola.

Regarding item (6), applicant has not provided a statement that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. (See MPEP 409.03(g)).

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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